

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Inventor: Raymond Hesline

Serial Number: 10/553,132

Group Art Unit: 2872

Filed: October 14, 2005

Examiner: Derek S. Chapel

Title: Optical Isolator, Attenuator, Circulator and Switch

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Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O.Box 1450
Alexandria, Va 22313-1450

Dear Sir,

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

This is a reply to the Examiner's Answer which was mailed November 24, 2010.

EXAMINER'S ARGUMENTS

1. The Examiner asserts that U.S. Patent Number 5,864,428 qualifies as prior art under 35 USC 102(b) and is a statutory bar under 35 USC 102(b). He supports this claim by quoting 35 U.S.C. 102(b).
2. In subsequent arguments the Examiner relies solely on MPEP 2141.01 to asserts that U.S. Patent Number 5,864,428 (applicant's own work) need not anticipate the claim of the pending

application and that date limitations for 35 U.S.C. 102(b) may be applied when a rejection is made under 35 U.S.C. 103(a).

APPELLANT'S REPLY

1. Appellant has shown in his Appeal Brief that the Examiner's statement "Hesline qualifies as prior art under 35 U.S.C. 102(b)" is not supported by his quotation.

2. Examiner states:

Further, as set forth in at least Advisory Office Actions mailed 3/26/2010 and 4/9/2010, MPEP 2141.01 shows that a reference used in an obviousness rejection (35 U.S.C. 103(a)) is eligible as prior art even if it is the Appellant's own work as long as it meets the date requirements of 35 U.S.C. 102(b). This is regardless of the fact that the reference may not entirely read on all the claim limitations (anticipated) to be used as a rejection under 35 U.S.C. 102. See specifically MPEP 2141.01:

"A 35 U.S.C. 103 rejection is based on 35 U.S.C. 102(a), 102(b), 102(e), etc. depending on the type of prior art reference used and its publication date. For instance, an obviousness rejection over a U.S. patent which was issued more than 1 year before the filing date of the application is said to be a statutory bar just as if it anticipated the claim under 35 U.S.C. 102(b) . . ."

(Examiner's Answer, page 11, line 19 to page 12, line 8.)

Examiner's quotation from MPEP 2141.01 begins "A 35 U.S.C. 103 rejection is based on 35 U.S.C. 102(a), 102(b) . . ." Examiner's rejection was based on prior art that is only available under 35 U.S.C. 103, that is the Examiner's rejection was *based on* 35 U.S.C. 103.

For a 35 U.S.C. 103 rejection to be *based on* 35 U.S.C. 102, as in the Examiner's quotation, the reference must anticipate the claim. See MPEP 706.02 V. Distinction between 35 U.S.C. 102 and 103:

The distinction between rejections based on 35 U.S.C. 102 and those based on 35 U.S.C. 103 should be kept in mind. Under the former, the claim is anticipated by the reference. No question of obviousness is present. In other words, for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. Whereas, in a rejection based on 35 U.S.C. 103, the reference teachings must somehow be modified in order to meet the claims. The modification must be one which would have been obvious to one of ordinary skill in the art at the time the invention was made.

Appellant contends that the Examiner's assertion:

a reference used in an obviousness rejection (35 U.S.C. 103(a)) is eligible as prior art even if it is the Appellant's own work as long as it meets the date requirements of 35 U.S.C. 102(b). This is regardless of the fact that the reference may not entirely read on all the claim limitations (anticipated) to be used as a rejection under 35 U.S.C. 102.

is not supported by his reference to MPEP 2141.01. The prior art reference must anticipate the claim whether the rejection is made under 35 U.S.C. 102(b) or 35 U.S.C. 103(a) based on 35 U.S.C. 102(b).

Rejections under 35 U.S.C. 103(a) based on 35 U.S.C. 103 are not mentioned in the Examiner's reference, but are addressed in the Appellant's Appeal Brief:

[T]he work of the same inventive entity may not be considered prior art against the claims unless it falls under one of the statutory categories.

(Appeal Brief, page 5, line 31 to page 6, line 1)

CONCLUSION

For the reasons set forth above, and in the Appellant's Appeal Brief, Appellant requests that the rejection of claims 13-20 be withdrawn and that a Notice of Allowance be issued for the pending claims.

Respectfully submitted,

/Raymond Hesline/
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